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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/805,337	03/22/2004	Norbert Stadele	STADELE2	9096

1444 7590 11/26/2008

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EXAMINER	
MUSSER, BARBARA J	
ART UNIT	PAPER NUMBER
1791	

MAIL DATE	DELIVERY MODE
11/26/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/805,337	STADELE, NORBERT	
	Examiner	Art Unit	
	BARBARA J. MUSSER	1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on *23 June 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *9-12* is/are pending in the application.

4a) Of the above claim(s) *10* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *9,11 and 12* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 9, 11, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alden(WO 2004/041541A1) in view of Welschlau (US Patent 4,587,898) as evidenced by Spann, and further in view of Loffler(U.S. Patent 5,602,746)

Alden discloses a method of printed corrugated board wherein pre-formed sheets of corrugated board are printed using an ink-jet printer, and cut in accordance with the printed design.(Abstract; Pg. 2, ll. 26-27) The reference does not disclose this process being part of in-line formation the corrugated web. Welschlau discloses forming a corrugated board by printing on a continuous web, joining the web with a corrugated web, and cutting the formed corrugated product.(Figure 1; Col. 6, ll. 4-12) It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the process of Alden inline wherein the corrugated board is formed and then printed and cut since Welschlau discloses forming and cutting a corrugated web in an inline process and since this would allow continuous formation of the product. While Alden does not disclose the printer is a digital printer, Spann is cited to show that an ink jet printer is considered a digital dot matrix printer.(Col. 1, ll. 13-15) Thus the ink jet printer of Alden is considered a digital printing process.

The references cited above do not disclose a method to determine the shrinkage of the corrugated board or a method of determining scaling factors. Loeffler discloses printing on a sheet whose outer dimensions can change due to drying or dampening. The references discloses using sensors to determine the locations of marks on the paper to determine the amount of change in the outer dimensions and to compensate for this change when making the printing form.(Col. 2, ll. 3-6; Col. 3, ll. 48-57; Col. 4, ll. 48-53) The reference does not clearly disclose how this compensation occurs, but one in the art would appreciate that compensating for the change in size of the printed image would require changing the size of the printing. It would have been obvious to one of ordinary skill in the art at the time the invention was made to determine the shrinkage or expansion of the corrugated board by placing marks on the board and measuring their spacing downstream using a sensor to determine the change in the image size to modify the printing size upstream so that the final image is the desired size since Loeffler discloses using marks to determine the amount of shrinkage or growth in the web so that the image can be altered to compensate for changes in the size of the printed image. (Col. 2, ll. 3-6; Col. 3, ll. 48-57; Col. 4, ll. 48-53)

Regarding claim 11, Alden discloses printing after forming the corrugated web.

Regarding claim 12, Loeffler discloses marking can be used in the direction of the length and width of the web.(Col. 4, ll. 52-56) One in the art would appreciate that the marking could be in any direction and that placing the marks parallel and perpendicular to the web movement would have been obvious since these are the obvious places to place such marks.

Response to Arguments

3. Applicant's arguments filed 6/23/08 have been fully considered but they are not persuasive.

Regarding applicant's argument that Alden does not disclose a device for making a corrugated web, examiner agrees. Examiner has not suggested that Alden discloses a method of making a corrugated web. Welschlau is used to show a conventional device for forming corrugated web.

Regarding applicant's argument that Alden does not teach a corrugated web at all, but only precut corrugated board, since corrugated board is made from cutting corrugated web into pieces, examiner does not understand the basis of applicant's argument. Examiner hopes applicant is not suggesting that one in the art would not understand how a corrugated web could be cut to make individual corrugated boards. Clearly, the corrugated board in Alden came from a corrugated web which was cut into pieces since the extremely well-known and conventional method of forming corrugated board is a continuous process.

Regarding applicant's argument that Alden does not disclose or recognize any problem with shrinkage, the fact that a reference does not recognize a problem that is recognized elsewhere does not mean that an invention is patentable.

Regarding applicant's argument that Welschlau does not address the concept of scaling factors, Loeffler suggests the modification of the printing based on changes to the paper dimensions.

Regarding applicant's argument that Welschlau does not disclose digital printing, Alden does.

Regarding applicant's argument that Welschlau contains printing forms, etc., Welschlau is cited to show it is known to form corrugated board and print on it, thus suggesting making the corrugated board in Alden and printing on it, not taking the process of Welschlau wholesale into Alden.

Regarding applicant's argument that there is no need to form the board in-line in Alden, the question is not whether there is any need, it is whether it would have been obvious. Batch and continuous processes are well-known alternatives in the art, so well-known the differences between them are taught in college. Substitution of one known process, printing on separate pieces, for another, printing on the continuous web, are known alternatives to one another.

Regarding applicant's argument that there is no teaching as to how to use digital printing on a continuous process, printing in an in-line process would appear to quite obvious since conventional printers associated with computer are digital printers and can print continuously, i.e. banners. Applicant has shown no evidence that one in the art would not known how to use a digital printer in a continuous process.

Regarding applicant's argument that examiner is replacing the digital printer of Alden with the rotary printer of Welschlau, examiner is using Welschlau to show it is known to form corrugated board and print on it, thus suggesting making the corrugated board in Alden and printing on it, not taking the process of Welschlau wholesale into Alden.

Regarding applicant's argument that using the concept of unroll stands and a corrugated board making apparatus from Welschlau is taking the process wholesale into Alden, examiner is taking the concept of a continuous process of making corrugated web and printing on it from Welschlau and modifying Alden to do the same. Clearly since Alden does not disclose this corrugated board making apparatus, the device used would be used in Alden as it is an obvious choice for the device since it already shows a device capable of forming a corrugated board and using it in a printing process.

Regarding applicant's argument that Alden does not use a heater so there would be no shrinkage, applicant's claim does not require a heater, only that a change in size of the image can occur from one step to the next. This can be due to humidity in the room, expansion of the faceboard due to the ink, stretching of the board as it passes through the process as well as the use of a heater and all of these could cause a change in the image size between one step and the next.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BARBARA J. MUSSER whose telephone number is (571)272-1222. The examiner can normally be reached on Monday-Thursday; alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571)-272-1226. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BJM
/B. J. M./
Examiner, Art Unit 1791

/Justin R Fischer/
Primary Examiner, Art Unit 1791